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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,520	01/18/2002	Harry Giewercer		7761

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EXAMINER

HOOLAHAN, AMANDA J

ART UNIT	PAPER NUMBER
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2859

DATE MAILED: 04/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/050,520

Applicant(s)

GIEWERCER, HARRY

Examiner

Amanda J Hoolahan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2003 and 11 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear how the band support and prescription label can be mechanically separated into two separate parts when, as previously claimed in claim 31, the band support *is* the prescription label. For further examination, the examiner will assume that there is only one item named band support/prescription label.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 19-25, 28-31, 34, 36, and 37 are finally rejected under 35 U.S.C. 102(b) as being unpatentable by USPN 5,482,163 to Hoffman.

Numerals A and B have been added to Figure 6 in reference to certain components of the invention disclosed by Hoffman. See copy attached at the end of this action.

Hoffman discloses a device comprising a cylindrical container (102) having an exterior side surface; a deformable band member (150); means for mounting (154) said band member on said exterior side surface of said container such that said band member forms a closed loop around said exterior side surface, the closed loop band member rotatable as such about said exterior side surface of said container to each of a plurality of selected positions; said band member defines a structural area for engagement; a band support member (40), the band support member having means for attachment (28) to the side of said container; said band support member is deformable (column 2, lines 45-47); the band support member defines a structural area adapted to receive engagement therewith said band member; said band support member and said band member include co-operating indicia (A); said co-operating indicia includes an arrangement of times (B) co-operating with a pointer (158) adapted to point to any one of said times; band member has gripping means (45) to aid grasping said band for displacement; band support member has anti-displacement means (44) for limiting displacement of said band member; band support member is a prescription label.

With respect to claim 28 (i.e., and the band member being adhesively formed into a closed loop): This is a “product by process” claim since the claim language is directed to the steps required to form the closed loop. Therefore, this step has been given no patentable weight since it has been held that 1) the determination of patentability in “product by process” claims is based on the product itself, even though such claims are limited and defined by the process, and 2) the product in a “product by process” claim is unpatentable if it is the same as, or obvious from a product of the prior art, even if the prior art was made by a different process. In re Thorpe et al., 227 USPQ 964 (Fed. Cir. 1985).

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Normal use of the device disclosed by Hoffman comprises the method steps as described in claims 34, 36, and 37.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 26, 27, 32, and 35 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman in view of USPN 3,757,441 to Baustin.

Hoffman discloses the device as described above in paragraph 4.

Hoffman does not disclose the indicia on the device being inscribed; and the band support member being adhesively attached to said container.

With respect to claim 26: Baustin discloses a device having indicia (12) that is inscribed. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the indicia, as taught by Hoffman, to be inscribed, as taught by Baustin, in order for the indicia to be permanent on the device which runs less of a risk of the indicia rubbing off.

With respect to claims 27 and 32: Baustin discloses a band member being adhesively attached to a container (column 2, lines 57-60). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to attach the device to

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the container, as taught by Hoffman, with an adhesive, as taught by Baustin, in order for the device to have a more secure attachment to the medicament container.

With respect to claim 35: Normal use of the device disclosed by Hoffman and Baustin as described above comprise the method step as described in this claim.

Response to Arguments

7. In response to applicant's argument that the band member in the Hoffman reference does not form a closed loop: Applicant's argument has been considered and is not persuasive. The band member disclosed by Hoffman does, in fact, form a closed loop around the medicament container (see rejection to claim 19 above).

In response to applicant's argument that the band support disclosed by Hoffman is not a prescription label: Applicant's argument has been considered and is not persuasive. The band support disclosed by Hoffman can also be considered a prescription label because the band support shows times in which a medication is to be taken, thus making it a prescription label. A label can be any printed matter to furnish any information.

Applicant's arguments with respect to claims 5, 9, 10, 11, 12, and 14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda J Hoolahan whose telephone number is (703) 308-0139. The examiner can normally be reached on Monday through Friday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

ajh
April 4, 2003



Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800